

Applicant submits that the proposed drawing change, together with the amendment to the specification, overcomes the objection to the drawing set forth in the outstanding Office Action. Applicant respectfully requests withdrawal thereof.

The examiner has rejected all of the pending claims over the same basic combination of references, the Swiss Colony Christmas Gift Book, U.S. Patent No. 4,203,516 to Stonoga et al., and the Money Magazine article. Various other references are combined with these three references to reject various of the dependent claims. However, since applicant specifically traverses the basic obviousness rejection, most of these additional references will not be discussed in any detail.

The examiner cites the Swiss Colony reference for teaching an edible greeting card with an edible message. The examiner admits that none of the products depicted in the Swiss Colony reference are intended to be eaten by pets and none of the edible messages are specifically designated for pets. The examiner cites the Stonoga et al. patent for teaching a greeting card designed for pets which includes a pet edible product, such as a dog biscuit. The reference is also cited for teaching the inclusion of a message on the card "bearing indicia relating to the pet for whom the product is designed." The Money Magazine article is cited for teaching pet greeting cards which contain a half ounce envelope of crackers meant to be ingested by the pet. The examiner additionally cites this reference as disclosing that "the fastest growing segment of the \$14 billion pet food industry is novelty items for pets."

Accordingly, the examiner believes it would be obvious to modify the human edible chocolate greeting cards disclosed in Swiss Colony "so that the materials of composition and messages would be suitable for a broader market which includes

edible greeting cards suitable for ingestion by pets as per the teachings of Stonoga et al. and the Money Magazine article in order to gain a portion of the pet food industry market that specializes in lucrative novelty pet items."

Applicant respectfully points out that the above quotation, which is taken directly from the outstanding office action on page 3 thereof, contains a misstatement. Neither Stonoga nor the Money Market article contain any teachings related to "edible greeting cards suitable for ingestion by pets." The greeting card of Stonoga et al. is described in detail in the '516 patent. According to the first sentence of the Introduction, it is directed to pet owners, not the pets, themselves. Furthermore, column 1, lines 47-50, discloses that Stonoga's greeting card "is composed of a pair of panels 10 and 12 integrally connected by a spine section 14 together cut from a heavy paper or cardboard like material." Furthermore, the Stonoga card also contains "a block 30 made of an inexpensive foam plastic material such as styrene . . . substantially the same plan dimensions as the front and rear panels 10 and 12 . . ." (Column 1, lines 61-64). Obviously, a greeting card which is constructed of such materials as cardboard and styrene is not intended to be "suitable for ingestion by pets." In fact, it is only the dog biscuit which is attached to the card which is pet edible. The Money Magazine article contains no description whatsoever as to the nature of the materials of which the pet greeting cards are made. Since they are described as containing "a half ounce envelope of crackers," this gives rise to the natural inference that the cards, themselves, are most likely formed of non-edible materials like the Stonoga et al. cards. Applicant raises this important point because these two references must be evaluated only for that which they fairly teach.

Applicant admits that they teach greeting cards directed at pet owners, but the cards themselves, are not edible by their pets. Rather, the prior art cards have attached to them pet edible products. In other words, both of these references teach the combination of a standard non-edible greeting card combined with an edible pet product.

Applicant queries, how would one of skill in the art, having the benefit of the teachings of the three main references, make the leap from a non-edible card with attached food product to an entirely pet-edible card? There is certainly no disclosure in the Swiss Colony reference of modifying the cards disclosed therein so that they are formed of pet-edible materials. In fact, the reference teaches away from this type of construction since the only edible material disclosed therein, namely, chocolate, is known to be highly toxic to house pets such as dogs and cats. If the average dog were to consume the entirety of one of the Swiss Colony chocolate cards, the dose of theobromine ingested would be sufficient to cause death.

The only motivation to combine these three references which the examiner sets forth is "to gain a portion of the pet food industry market that specializes in lucrative novelty pet items." Such a vague motivation amounts to little more than saying an inventor is motivated by the desire to sell his product and make money. Why would anyone who has this desire be motivated to combine these particular references in the particular way suggested by the examiner? The only reason, applicant submits, is if that person had the benefit of the disclosure of applicant's own invention. In other words, the examiner's obviousness rejection represents nothing but a hindsight reconstruction of the invention taken in piecemeal from various pieces of prior art.

As the examiner is aware, the Court of Appeals for the Federal Circuit requires that the references, or the prior art as a whole, contain some teaching that would motivate one of skill in the art to combine and modify the references in the particular way suggested by the examiner to achieve the claimed invention. See, for example, *In re Laskowski*, 13 USPQ 1098 (CAFC 1989). Since the examiner has failed to cite anything, other than a vague desire to exploit a lucrative market, the obviousness rejection is fatally flawed, insufficient on its face and should be withdrawn.

Applicant points to the fact that this invention is presently being infringed by at least two different parties. The facts of the infringement are set forth in applicant's Petition to Make Special and supporting papers, which petition was granted by the Patent Office. As the examiner is aware, such widespread copying is, itself, one of the classic secondary indicia of patentability and such evidence must be given due weight in arriving at a determination of whether an invention is or is not obvious. *In re Sernaker*, 217 USPQ 1, (CAFC 1983). Apparently, the infringers think that applicant's invention is a good idea or they would not have hastened to copy it and put it on the market. After all, the three references combined by the examiner to make the obviousness rejection all date from at least ten years ago. All of these teachings were available to those of skill in the art for all these years. If the invention was so obvious, why did these infringements start occurring only after applicant made his invention?

Thus, to the extent that the examiner's obviousness rejection represents any kind of a *prima facie* case of obviousness, the evidence of record already filed by

applicant represents a strong rebuttal. Accordingly, the rejection should be withdrawn.

Applicant has two additional comments concerning various of the dependent claims and what is taught by the cited references. Claim 4 contains the additional limitation of the means for positioning the card comprising a thicker supporting section positioned along the perimeter of the card so that the card may be supported on a horizontal surface. The examiner cites the Swiss Colony item number 1516 as disclosing such a supporting section. However, applicant has carefully examined the two views of this product contained in the reference and is unable to see such a structure clearly disclosed. While it is true that item number 1516 is shown displayed in a more or less vertical position, the same could be said about a number of the other products, such as the "Merry Chris Mouse" card which is contained within a shipping box. Since neither photograph permits an inspection of the rear surface of the card to see how it is being supported, it is impermissible to draw the conclusion made by the examiner, namely, that there is a peripherally thickened portion. For this additional reason, claim 4 is not obvious over this combination of references.

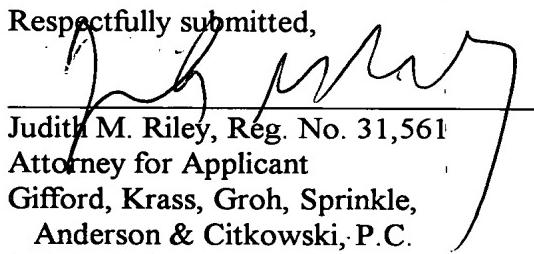
With regard to claim 13, the Stewart reference teaches nothing more than edible films and the method of using them for decorating foodstuffs. Yet, the claim requires that the means for creating the edible message be "in the form of a marker containing a quantity of edible ink sufficient to create an edible message." How would one of skill in the art, having the benefit of the teaching of edible films disclosed in Stewart, make the inventive leap to supply a device with the pet greeting card which

permits the sender to apply his/her own message? For this separate and additional reason, claim 13 is patentable over this particular combination of references.

In summary, none of the prior art taken either singly or in any permissible combination thereof discloses a greeting card suitable for pets which is composed of a pet edible material and has disposed thereon a pet edible message. Furthermore, there is no disclosure, teaching or suggestion in any of the prior art of record which would motivate one to combine various features disclosed in single references to arrive at the unique and inventive combination of features claimed by applicant. Furthermore, the additional limitations of claims 4 and 13 are not disclosed in any fashion in the prior art. Accordingly, all of the claims are in condition for immediate allowance, and applicant respectfully requests expeditious notice thereof.

Should the examiner have any questions or comments concerning this application, she is respectfully requested to contact the undersigned attorney at the office number below.

Respectfully submitted,

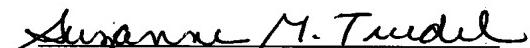


Judith M. Riley, Reg. No. 31,561
Attorney for Applicant
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C.
280 N. Old Woodward Ave., Suite 400
Birmingham, MI 48009-5394
(248) 647-6000

JMR/gs

CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below with sufficient postage as First Class Mail in an envelope addressed to: Box Non-Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231 on 5-21-99


Suzanne M. Trudel